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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/476,415	12/30/1999	DALE SANDBERG	3855.29	7821

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EXAMINER

BLECK, CAROLYN M

ART UNIT	PAPER NUMBER
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3626

DATE MAILED: 11/28/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/476,415

Applicant(s)

SANDBERG, DALE

Examiner

Carolyn M Bleck

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 30 October 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 21-29,31-38,40 and 41 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 21-29,31-38,40 and 41 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- ☐ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____
- ☐ Interview Summary (PTO-413) Paper No(s). _____
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: _____

DETAILED ACTION

Notice to Applicant

1. This communication is response to the amendment filed 30 October 2003.
Claims 21-29, 31-38, and 40-41 are pending. Claims 30 and 39 have been cancelled.
Claims 21-28, 31-38, and 40 have been amended.

Specification

2. The objection to the specification is hereby withdrawn due to the amendment filed 30 October 2003.

Claim Rejections - 35 USC § 112

3. The rejection of claims 21-29, 31-38, and 40-41 under 35 USC 112 is hereby withdrawn due to the amendment filed 30 October 2003.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. Claims 21-29, 31-38, and 40-41 are rejected under 35 U.S.C. 103(a) as being unpatentable over Evans (5,924,074) in view of Feldon et al. (5,732,221) for

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substantially the same reasons given in the previous Office Action (paper number 11).

Further reasons appear below.

(A) As per claims 21- 22, 24-25, and 31-32, Evans discloses a medical records method and system for storage and retrieval of dynamic electronic medical records in a computer environment, such as a local or wide area network including portable computers (col. 1 lines 5-10), wherein patient data, such as patient complaints, lab orders, medications, diagnoses, and procedures, are captured at the point of care of a patient in real-time, such as during an examination or in hospital (see Figure 24), using a graphical user interface having touch screens in a point of care system (Abstract; lines 1-5; col. 2 lines 20-64, col. 5 lines 29-55, and col. 5 lines 8-10), comprising:

(a) selecting a procedure from a list of procedures administered by a physician of a healthcare facility, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(b) selecting a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64);

(c) activating the form for use by a health care provider when diagnosing and performing a procedure or administering a treatment on a patient (Figures 1,5-6, 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64); and

(d) using the form to select a procedure, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64) and to select a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64).

Evans fails to expressly recite a "customizable form".

Feldon discloses entering a patient's demographic information, medical history, prescribed medication and other relevant information for a patient, including information a physician documents during the exam using exam descriptors, into data entry forms, wherein a user is able to customize these data entry forms by editing existing forms or by redesigning completely new forms, wherein the form is able to be saved using a computer (Figure 1, col. 4 lines 13-63, col. 8 lines 62-67, and col. 9 lines 15-65, col. 11 lines 1-58, and col. 12 lines 1-9).

At the time the invention was made, it would have been obvious to a person of ordinary skill in the art to include the aforementioned features of Feldon within the method of Evans with the motivation of allowing forms to be generated based on the user's needs and customized for the particular task at hand (Feldon; col. 4 lines 52-54) and transforming a patient chart from a static record of a few clinical interactions into a dynamic, real-time comprehensive record (Evans; col. 2 lines 34-40).

(B) The amendments to claims 23 and 26-28 appear to have been made to correct 35 USC 112 issues or to reflect the changes made in claim 21, but otherwise do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 11; sections 3(B)-(D); pages 9-10), and incorporated herein.

(C) Claim 29 has not been amended and is rejected for the same reasons given in the prior Office Action (paper number 11; section 3(D); page 10).

(D) The amendments to claim 33 reflect the same changes made to claim 21, discussed above, and is therefore rejected for the same reasons given above for claim. 21 in addition to the rejections made for claim 33 in the prior Office Action (paper number 11; section 3; pages 6-11).

(E) The amendments to claims 34-38 and 40 appear to have been made to correct 35 USC 112 issues or to reflect the changes made in claim 33, but otherwise do not affect the scope and breadth of the claim as originally presented and/or in the manner in which the claim was interpreted by the Examiner when applying prior art within the previous Office Action.

As such the recited claimed features are rejected for the same reasons given in the prior Office Action (paper number 11; sections 3(B)-(E); pages 9-11), and incorporated herein.

(F) Claim 41 has not been amended and is rejected for the same reasons given in the prior Office Action (paper number 11; section 3(E); pages 10-11).

Response to Arguments

6. Applicant's arguments filed 30 October 2003 have been fully considered but they are not persuasive. The arguments will be addressed below in the order in which they appear in the response filed 30 October 2003.

(A) At pages 11-13 of the 30 October 2003 response, Applicant argues that the applied references do not teach all of the features of the claimed invention. In particular, Applicant argues the applied references do not teach generating a customizable form based on electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of healthcare facility for inclusion in a customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider.

In response to applicant's arguments, the Examiner respectfully submits that the Applicant is viewing the references individually. One cannot show nonobviousness by attacking references individually where the rejections are based on combinations of

references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986). In addition, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Furthermore, the Examiner respectfully submits that Evans was relied upon for teaching Applicant's feature of "a form based on electronically selecting a pool of healthcare procedures characteristically performed by a particular healthcare provider of a healthcare facility for inclusion in a customizable form, wherein the pool of healthcare procedures reflect the medical services rendered by the particular healthcare provider." Note Evans teachings discussed above in the rejection of claim 21, activating the form for use by a health care provider when diagnosing and performing a procedure or administering a treatment on a patient (Figures 1,5-6, 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64), and using the form to select a procedure, wherein the procedures reflect treatments of a physician, and wherein the procedures are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64) and to select a diagnosis from a list of diagnoses made by a physician of a healthcare facility, wherein the diagnosis indicates the proper administration of procedures to be performed by a physician, and wherein the diagnoses are included in a form (Figures 20, 24, col. 6 line 10 to col. 11 line 40, col. 11 lines 9-64). Feldon was relied upon for teaching a

"customizable form". Note Feldon's teachings of entering a patient's demographic information, medical history, prescribed medication and other relevant information for a patient, including information a physician documents during the exam using exam descriptors, into data entry forms, wherein a user is able to customize these data entry forms by editing existing forms or by redesigning completely new forms, wherein the form is able to be saved using a computer (Figure 1, col. 4 lines 13-63, col. 8 lines 62-67, and col. 9 lines 15-65, col. 11 lines 1-58, and col. 12 lines 1-9). Thus, the proper combination of Evans and Feldon would be Evans method for activating a form and entering data within the form with that of Feldon's customizable form. The motivation being allowing forms to be generated based on the user's needs and customized for the particular task at hand (Feldon; col. 4 lines 52-54) and transforming a patient chart from a static record of a few clinical interactions into a dynamic, real-time comprehensive record (Evans; col. 2 lines 34-40). Thus, the Examiner maintains the combination of Feldon within Evans is a proper combination, and thus the rejection is maintained.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within

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TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn Bleck whose telephone number is (703) 305-3981. The Examiner can normally be reached on Monday-Thursday, 8:00am – 5:30pm, and from 8:30am – 5:00pm on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph Thomas can be reached at (703) 305-9588.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Receptionist whose telephone number is (703) 306-1113.

9. **Any response to this action should be mailed to:**

Commissioner of Patents and Trademarks
Washington, D.C. 20231

Or faxed to:

(703) 872-9306 or (703) 872-9326 [Official communications]

(703) 872-9327 [After Final communications labeled "Box AF"]


(703) 746-8374 [Informal/ Draft communications, labeled
"PROPOSED" or "DRAFT"]

Hand-delivered responses should be brought to Crystal Park 5, 2451 Crystal Drive,
Arlington, VA, 7th Floor (Receptionist).

CB

CB

November 25, 2003


JOSEPH THOMAS
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